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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,056	10/15/2001	William D. Meadow	051874-0112	1667
22428	7590	09/22/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/976,056	Applicant(s) MEADOW ET AL.	
	Examiner John M Winter	Art Unit 3621	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

- 121:
1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3 drawn to conducting secure transactions including authentication, classified in class 705 subclass 67.
 - II. Claims 4-6, drawn to a specialized check printer, classified in class 705 subclass 1.
 - III. Claims 7-9, drawn to transaction verification, classified in class 705 subclass 75.

Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I does not require a check printer or a hash value used to verify a check for online transactions. The subcombination has separate utility such as printing checks or verifying online transactions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via the paper filed on July 14, 2004 the applicant has elected the examination of invention I directed towards claims 1-3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-3 and 10-13 have been examined

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen et al., (US Patent Application Publication US 2002/0002674)

As per claim 10

Rosen ('407) discloses a system for verifying a check that is being used for an online transaction made over a computer network, comprising:

An input unit, A web server, A check verifier(Figure 3)

The terms "receiving, from a customer, MICR data obtained from a MICR line of the check and "private data of the customer, the MICR data including first MICR data that corresponds to bank account information and second MICR data that includes a one-way hash value that is computed based on the first MICR data and the private data of the customer that is not provided on the MICR line" and "receiving the MICR data and the private data from the input unit, as well as transaction data corresponding to a desired on-line transaction to be made by the customer, the MICR data and the private data and the transaction data being received by the web server by way of the computer network" and "verifier for receiving, by way of the computer network as output by the web server, the private data provided by the customer via the input unit and the MICR data provided by the customer via the input unit, wherein the check verifier verifies whether or not the check is valid by computing a hash value from: a) the first MICR data provided to the check verifier by way of the web server, and b) stored private data of the customer that is obtained from a database directly accessible by the check verifier." are a non-functional descriptive items. The terms "receiving, from a customer, MICR data obtained from a MICR line of the check and "private data of the customer, the MICR data including first MICR data that corresponds to bank account information and second MICR data that includes a one-way hash value that is computed based on the first MICR data and the private data of the customer that is not provided on the MICR line" and "receiving the MICR data and the private data from the input unit, as well as transaction data corresponding to a desired on-line transaction to be made by the customer, the MICR data and the private data and the transaction data being received by the web server by way of the computer network" and "verifier for receiving, by way of the computer network as output by the web server, the private data provided by the customer via the input unit and the MICR data provided by the customer via the input unit, wherein the check verifier verifies whether or not the check is valid by computing a hash value from: a) the first MICR data provided to the check verifier by way of the web server, and b) stored private data of the customer that is obtained from a database directly accessible by the check verifier." could be replaced with other terms. i.e. "for archiving information", etc and not change the limitations of the claim. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed

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invention "as a whole" would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other words **language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation.** See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

Allowable Subject Matter

Claims 1-3 are allowable over the prior art record

Claims 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

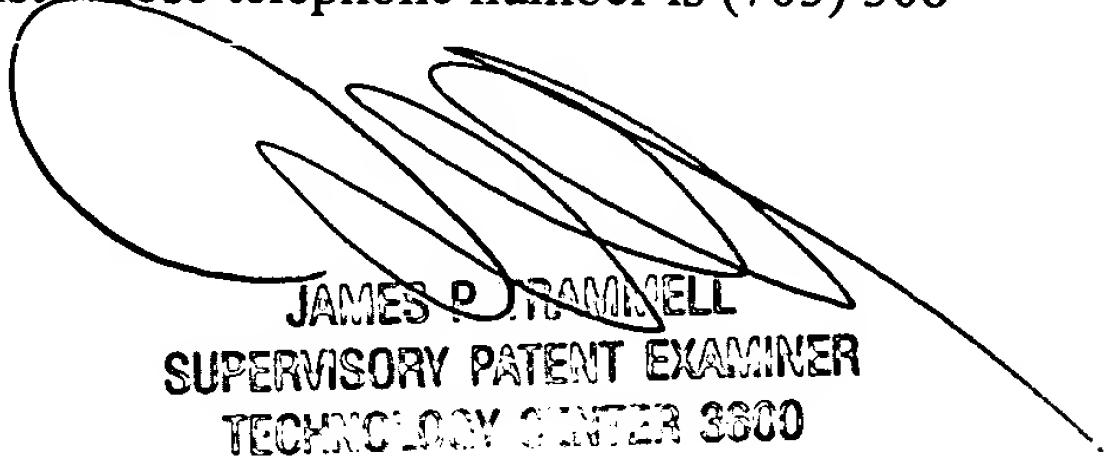
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

September 20, 2004
JMW



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600